

REMARKS

This paper is presented in response to the Office Action. By this paper, claims 1-5, 7-11, 13-14 and 16-17 are amended and new claims 19-28 are added. Claims 6, 12, 15 and 18 were canceled in a previous paper. Claims 1-5, 7-11, 13-14, 16-17 and 19-28 are now pending in light of the aforementioned cancellations and new claims.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, the remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Rejection of Claims 1, 2, 5, 7-8 and 11 Under 35 U.S.C. §102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the

claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure ("MPEP") § 2131.*

The Examiner has rejected claims 1, 2, 5, 7-8 and 11 under 35 U.S.C. § 102(e) as anticipated by US 6,556,445 to Medina ("*Medina*"). Applicant respectfully disagrees.

a. claims 1, 2 and 5

Applicant has amended claim 1 herein to recite "... a movable pivot block rotatably engaged with the cable receptacle and having a locking member that is configured to selectively engage a host port, the pivot block being configured to allow removal of the module from within a host port, wherein movement of the pivot block manipulates the locking member in a manner so as to disengage the module from within the host port." *Emphasis added.* Support for the amendment to claim 1 can be found in the application, for example, at Figures 3a and 3b.

In contrast, it does not appear from *Medina* that the "movable pivot lever 38" is rotatably attached to a cable receptacle, or to any other structure for that matter. Further, it does not appear from *Medina* that the "locking member 36" is configured to selectively engage the receptacle 12. Instead, *Medina* discloses that with respect to tab 32, which is not a part of "movable pivot lever 38" as claim 1 requires, "The wedge 36 is forced between the tab 32 and the slot 22 by a person pressing on a lever 38 attached to the wedge 36. When a person presses upon the lever 38, the wedge 36 slides under the lip 30 and forces apart the tab 32 from the slot 22, thus unlocking the transceiver module 10 from the receptacle 12." *Fig. 1, col. 3, lines 49-54. Emphasis added.*

Claim 1, as amended herein, also distinguishes over US 5,901,263 to Gaio et al. ("*Gaio*"). As noted above, amended claim 1 requires, among other things "... a movable pivot block rotatably engaged with the cable receptacle and having a locking member that is configured to selectively engage a host port, the pivot block being configured to allow removal of the module from within a host port, wherein movement of the pivot block manipulates the locking member in a manner so as to disengage the module from within the host port." *Emphasis added.* In this regard, Applicant notes that the Examiner has previously characterized element 104 of *Gaio* as corresponding to the claimed "pivot lever" (now, "pivot block") (see *Office Action mailed September 2, 2004*).

In fact however, *Gaio* discloses that "the optical fiber connection unit is molded with retaining clips 104 having detents 104' projecting outwardly therefrom" and "When pressed into the latched or

down position the bail 102 rides up inclined plane 106 to plateau 106' and the retaining clips 104 are forced outwardly to contact the host system.” *Col. 3, lines 26-28, and lines 42-47. Emphasis added.*

Thus, *Gaio* contrasts with claim 1 at least insofar as the foregoing passages of *Gaio* disclose that the latching and unlatching of the *Gaio* module requires the use of two structures, namely, a pair of retaining clips 104. In contrast, claim 1 recites that “movement of the pivot block manipulates the locking member in a manner so as to disengage the module from within the host port.” *Emphasis added.* Stated another way, it seems clear from the foregoing passages of *Gaio* that, in contrast with the device to which claim 1 is directed, the *Gaio* device is not configured so that motion of only a single retaining clip 104, purported by the Examiner to correspond with the claimed “pivot lever,” is adequate to disengage the *Gaio* module from a host.

For at least the foregoing reasons, amended claim 1, as well as corresponding dependent claims 2 and 5, are patentably distinct from *Gaio*. Particularly, Applicant respectfully submits that the Examiner has not established that each and every element as set forth in claim 1 is found in *Medina* or in *Gaio*, nor has the Examiner established that the identical invention is shown in *Medina* or in *Gaio* in as complete detail as is contained in the claim. Applicant thus respectfully submits that the rejection of claim 1, as well as the rejection of corresponding dependent claims 2 and 5, should be withdrawn.

b. claims 7, 8 and 11

Similar to claim 1, claim 7 has been amended herein to recite “a movable pivot block rotatably engaged with the cable receptacle and having a locking member that is configured to selectively engage a host port, the pivot block being configured to allow removal of the module from within a host port, wherein movement of the pivot block manipulates the locking member in a manner so as to disengage the module from within the host port.” Support for the amendment to claim 7 can be found in the application, for example, at Figures 3a and 3b.

In view of the fact that the discussion of claim 1 above is germane as well to claim 7, Applicant respectfully directs the attention of the Examiner to such discussion. For at least the reasons outlined in that discussion, Applicant respectfully submits that the rejection of claim 7, as well as the rejection of corresponding dependent claims 8 and 11, should likewise be withdrawn.

III. Rejection of Claims 13, 15 and 16 Under 35 U.S.C. §103(a)

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

Turning now to the rejections, the Examiner has rejected claims 13, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Medina* in view of *Gaio* and in view of what the Examiner has characterized as “Applicant’s admitted prior art.” Applicant disagrees with the contentions of the Examiner however and submits that for at least the reasons outlined below, the rejection of claims 13, 15 and 16 should be withdrawn.

For example, in rejection claims 13, 15 and 16, the Examiner has characterized *Medina* as disclosing “a moveable pivot lever 38 [and] ... a locking member 38, formed on the pivot lever.” While it appears that the reference to a locking member “38” is a typographical error, in view of the assertion of the Examiner with respect to claim 1 that *Medina* discloses a “locking member 36,” the characterization of *Medina* advanced by the Examiner is incorrect in any event. Particularly, it was noted above in the discussion of claim 1 that it does not appear from *Medina* that the “locking member 36” is configured to selectively engage the receptacle 12, as the Examiner has asserted. Instead, *Medina* discloses with respect to tab 32, which is not a part of “movable pivot lever 38” (see *Figure 2*) as claim 1 requires, that “The wedge 36 is forced between the tab 32 and the slot 22 by a person pressing on a lever 38 attached to the wedge 36. When a person presses upon the lever 38, the wedge 36 slides under the lip 30 and forces apart the tab 32 from the slot 22, thus unlocking the transceiver module 10 from the receptacle 12.” *Fig. 1, col. 3, lines 49-54. Emphasis added.*

Applicant thus respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 13, 15 and 16, at least because even if the references are combined in the purportedly obvious fashion advanced by the Examiner, the resulting combinations nonetheless fail to include all the limitations of the rejected claims. Applicant accordingly submits that that the rejection of claims 13, 15 and 16 should be withdrawn.

IV. Allowable Subject Matter

The Examiner has indicated that claims 3, 4, 9, 10 and 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the discussion and claim amendments set forth herein however, Applicant respectfully declines to amend those claims at this time.

As to the statement of reasons for patentability offered by the Examiner in regard to claims 3, 4, 9, 10 and 14, Applicant submits the following comments. In general, Applicant agrees with the Examiner that the inventions to which claims 3, 4, 9, 10 and 14 are directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 3, 4, 9, 10 and 14 in view of the cited references.

V. New Claims 19-28

New claims 19 to 28 are each directed to a combination that includes, among other things, "a pivot block rotatably engaging the connector portion, the pivot block being rotatable between a first pivot block position where the module is latched to a host port, and a second pivot block position where the module is unlatched from the host port" and claims 19-27 further recite the limitation "a bail secured in position on the connector portion by the pivot block." *Emphasis added*. Support for these new claims can be found, for example, at figures 3a, 3b, 7 and 8 of the application. At least because the Examiner has not demonstrated that the foregoing limitations are taught or suggested by the cited references (see, e.g., discussion at **II.a.** above), whether those references are considered individually or in combination, new claims 19-28 are believed to be in allowable condition.

As to the discussion, above, of new claims 19-28, Applicant respectfully notes that reference to various exemplary limitations of those new claims is not intended, nor should it be construed, to be either

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an admission or assertion by the Applicant that patentability of new claims 19-28, or any other claims, hinges on the presence of such limitations. Rather, Applicant submits that each of the now pending claims, considered in its respective entirety, patentably distinguishes over the reference cited by the Examiner.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-5, 7-11, 13-14, 16-17 and 19-28 is in condition for immediate allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 2nd day of November, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Malen Jr.', with a long horizontal flourish extending to the right.

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